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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,863	07/14/2000	KEITH DOUGLAS PERRING	LP4285	2545

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LEGAL PATENT RECORDS CENTER  
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WILMINGTON, DE 19805

[REDACTED] EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
1771	/D

DATE MAILED: 01/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/509,863	PERRING ET AL.
	Examiner	Art Unit
	Jeremy R. Pierce	1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 December 2002.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 112***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-11 are indefinite because claims merely setting forth physical characteristics desired in an article and not setting forth specific compositions, which would meet such characteristics are invalid as vague and indefinite because they cover any conceivable combination of ingredients, either presently existing or which might be discovered in the future. Claims 1-11 would impart desired characteristics too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition and, in effect, recites compounds by what it is desired that they do rather than what they are. *Ex parte Slob*, (PO BdApp) 157 USPQ 172. In this case, the desired characteristics include octanol/water partition coefficient values and gas chromatographic Kovats index values.

***Claim Rejections - 35 USC § 103***

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grohe (U.S. Patent No. 4,844,902).

Grohe discloses an elastic textile material coated or impregnated with a polymer (column 7, lines 1-3). The polymer may contain fragrant substances, such as menthol and thymol (column 8, lines 51-53). While Grohe does not teach the textile to be made of spandex, it is disclosed the textile may contain fibers and filaments made of polyamide-polyurethane (column 9, lines 41-44). Since spandex is made from fibers containing polyamide and polyurethane, it would have been obvious to a person having ordinary skill in the art to use spandex fibers in the elastic textile of Grohe, since spandex is a common type of polyamide-polyurethane fiber, and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The perfume composition would comprise at least 50% of menthol or thymol, especially if those were the only substances added to the polymer. With regard to claims 2 and 9, Grohe do not disclose the percentage of fibers in the textile that would be polyamide-polyurethane. However, the number of polyamide-polyurethane fibers is a variable that would affect the degree of elasticity of the textile. It would have been obvious to one having ordinary skill in the art to use between 0.5 and 50% by weight polyamide-polyurethane fibers in the textile in order to obtain the desired degree of elasticity in the textile, since it has been held that discovering an optimum value of a

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result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Also with regard to claims 2 and 9, Grohe do not disclose the amount of fragrance material present in the textile. However, the amount of fragrance material present in the textile is a variable that would affect the odorous strength of the textile. It would have been obvious to one having ordinary skill in the art to incorporate fragrance in the amount of 0.001 to 1% by weight of the textile in order to obtain the desired degree of odor in the textile, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

#### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-11 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,465,420. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '420 patent describes using the same perfume on yarn or fabric comprising spandex fibers. With regard to claims 2 and 9, the amount of fragrance material present in the textile is a variable that would affect the odorous strength of the textile. It would have been obvious to one having ordinary skill in the art to incorporate fragrance in the amount of 0.001 to 1% by weight of the textile in order to obtain the desired degree of odor in the textile, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

### ***Response to Arguments***

7. Applicant's arguments with respect to the art rejections to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.
8. Applicant argues that the pending claims are not indefinite under 35 USC 112 according to *Ex parte Slob* because the claims recite fragrances according to both chemical classes (alcohol, phenol, salicylate, ester, ether, nitrile, ketone, aldehyde) and two physical properties. Applicant argues that *Slob* only rejected claims that recited physical properties, and that dependent claims that further limited the claims according

to chemical class were only rejected because there was evidence that inoperable materials fell within the chemical class. However, Applicant's "chemical classes" (alcohol, phenol, salicylate, ester, ether, nitrile, ketone, aldehyde) are not limiting enough, because they still cover a great number of species that have been conceived and have not been conceived. While Applicant has limited the claims to materials that must fall within several broad classes, Applicant is essentially seeking patent protection on all future synthetic materials within these broad classes that might meet the claimed properties. There are any number of future materials that would fall within the broad class of materials claimed by Applicant and would also meet the claimed properties.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Japanese Patent 5-295667 to Ono et al. discloses using perfume compositions claimed by Applicant in various types of textile materials. Ono et al. also disclose the importance of using an elastic binder material to attach the perfume to the textiles so that the textiles retain their hand characteristics.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9310  
for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is (703) 308-  
0661.



Jeremy R. Pierce  
Examiner  
Art Unit 1771

December 31, 2002



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700